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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,089	08/22/2003	Gary Crawford	GBHS126617	9601
26389	7590	08/07/2006	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC			HOGAN, JAMES SEAN	
1420 FIFTH AVENUE			ART UNIT	
SUITE 2800			PAPER NUMBER	
SEATTLE, WA 98101-2347			3752	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,089

Applicant(s)

CRAWFORD, GARY

Examiner

James S. Hogan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

See following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-16 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

US patent application 2004/0035879 to Vergote appears to disclose and claim the same subject matter as disclosed and claimed herein. Further, it is noted that this application to Vergote lists the same provisional priority document (06/405,633) as listed herein. Therefore, a question of derivation exists in as much as review of the provisional priority document in common shows both Vergote and Crawford named as inventors. In the provisional priority application, Crawford added Vergote via petition received on October 8, 2002. Accordingly, it appears at minimum the present applicant derived at least part of the invention from another inventor which applicant admits in his priority application. Applicant should delineate that which he solely invented within the specification and claims or consider MPEP 201.03 if a correction of inventorship is warranted in the instant file.

Background

From MPEP 2137, where it can be shown that an applicant “derived” an invention from another, a rejection under 35 U.S.C. 102(f) is proper. See *Ex parte Kusko*, 215 USPQ 972, 974 (Bd. App. 1981) (“most, if not all, determinations under section 102(f)

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*involve the question of whether one party derived an invention from another”). While derivation will bar the issuance of a patent to the deriver, a disclosure by the deriver, absent a bar under 35 U.S.C. 102(b), will not bar the issuance of a patent to the party from which the subject matter was derived. See *In re Costello*, 717 F.2d 1346, 1349, 219 USPQ 389, 390-91 (Fed. Cir. 1983) (“[a] prior art reference that is not a statutory bar may be overcome by two generally recognized methods”: an affidavit under 37 CFR 1.131, or an affidavit under 37 CFR 1.132 “showing that the relevant disclosure is a description of the applicant’s own work”); *In re Facius*, 408 F.2d 1396, 1407, 161 USPQ 294, 302 (CCPA 1969) (subject matter incorporated into a patent that was brought to the attention of the patentee by applicant, and hence derived by the patentee from the applicant, is available for use against applicant unless applicant had actually invented the subject matter placed in the patent).*

Derivation Distinguished From Priority Of Invention

Although derivation and priority of invention both focus on inventorship, derivation addresses originality (i.e., who invented the subject matter), whereas priority focuses on which party first invented the subject matter. See *Price v. Symsek*, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Hogan whose telephone number is (571) 272-4902. The examiner can normally be reached on Mon-Fri, 7:00a-4:00p EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Scherbel can be reached on (571) 272-4919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSH
08/02/2006

A handwritten signature in black ink, appearing to read 'D. Scherbel', with a stylized, cursive script.

David A. Scherbel
Supervisory Patent Examiner
Group 3700